

REMARKS

Reconsideration of this application, in view of the foregoing amendment and the following remarks, is respectfully requested.

Claims 1-20 were originally presented for consideration and are currently pending in this application.

The following rejections were set forth in the Office Action:

1. Claim 5 stands rejected as indefinite under 35 U.S.C. §112.
2. Claims 1-5 and 7-20 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 7,665,537 (Patel).
3. Claim 6 stands rejected under 35 USC §103(a) as being unpatentable over Patel, and further in view of U.S. Patent No. 2,230,626 (Miller).

Regarding the indefiniteness rejection of claim 5 as lacking sufficient antecedent basis for the limitation “in reaction to exposure to the fluid in the space,” claim 5 depends from independent claim 1. Claim 1 requires “an expandable material,” “a retracted state,” “an expanded state,” “a fluid in the well system,” and “a space in a borehole.”

Claim 5 requires that the expandable material extends from the retracted state to the expanded state in reaction to exposure to the fluid in the space. The limitation of claim 5, which requires that “the expandable material extends in reaction to the fluid being in the space,” is fully supported by independent claim 1. However, claim 5 has been amended above to separately state that the fluid is in the space. Since there is proper antecedent basis for the limitations of claim 5, withdrawal of the indefiniteness rejection to this claim is respectfully requested.

Regarding the anticipation rejections of independent claims 1, 8 and 13, Patel does not disclose or suggest all the limitations of any one of these claims. Claim 1 requires a castable material disposed radially between and in contact with the borehole and the device. Claim 8 requires the castable material extending at least partially circumferentially about an annular element comprising an expandable material. Claim 13 requires the castable material being disposed radially between the expandable material and the borehole.

Patel discloses that cement may be injected between the seals 12 so that the casing is cemented within the borehole (FIG. 18; column 7, lines 36-38). However, Patel does not disclose or suggest that the castable material is disposed radially between the borehole and the swellable seal, as required by claims 1 and 13, or the castable material extends circumferentially about the swellable seal, as required by claim 8. As such, Patel cannot anticipate these claims. Therefore withdrawal of the anticipation rejections of independent claims 1, 8, and 13 is respectfully requested.

Regarding the remaining obviousness rejections, the rejected claims are considered allowable due to their dependence from claims shown above to be allowable. Therefore, withdrawal of the remaining obviousness rejections is respectfully requested.

In view of the foregoing amendment and remarks, all of the claims pending in this application are now seen to be in a condition for allowance. A Notice of Allowance of claims 1-20 is therefore earnestly solicited.

The examiner is hereby requested to telephone the undersigned agent of record at (214) 556-2332 if such would expedite the prosecution of the application.

Respectfully submitted,
SMITH IP SERVICES, P.C.

/David A. Pittman/

David A. Pittman
Agent for Applicant(s)
Registration No. 66,027

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P.O. Box 997
Rockwall, Texas 75087
(972) 516-0030 (phone)
(972) 516-0608 (fax)

I hereby certify that this correspondence is being
filed in the U.S. Patent and Trademark Office
electronically via EFS-Web, on September 14, 2010.

/Sally Ann Smith/

Sally Ann Smith